

Art Unit: 1625

- IV. Claim 8, drawn to a synthetic preparation method for preparing compounds described in the said claim. Classified in class 562 and subclass 460.

The inventions are distinct, each from the other because of the following reasons:

Group II and I are drawn to two different sets of crystal forms having presumably different method of preparation. Indeed, a reference disclosing or suggesting any one of the above groups does not anticipates or suggests the remaining group under the meaning of 35 USC 102 or 35 USC 103, respectively.

Inventions II, I and Invention III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case there are known compounds in the art that are inhibitors of nitric oxide, therefore the process of using can be practiced with an alternative compound not embraced in the instant claims.

Inventions II and I and invention IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process

Art Unit: 1625

(MPEP § 806.05(f)). In the instant case it is presumed that the compounds can be prepared by an alternative process, thus Group IV is different from Group I and II.

Because these inventions are distinct for the reasons given above and the search required for any of the groups is not required for the other groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

In the case that any of the Groups I or II are elected, the Examiner would be willing to rejoin the process to prepare the said elected compounds limited to the same allowable scope of the elected compounds and provided claims are free from ANY 112 issues.

Art Unit: 1625

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).


CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is (571) 272-0961. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rita Desai can be reached on (571) 272-0684. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Hector M. Reyes PhD JD
Reg. # P-54,846
AU 1625
September 7, 2004


PAUL J. KILLOS
PRIMARY EXAMINER